

REMARKS

This is in response to the Notice of Non-Compliant Amendment mailed on December 7, 2004, and further to the Office Action mailed on May 5, 2004.

Claim 1 has been amended to further clarify that the limitation regarding “performing a query function” comprises “generating a set of queries” and “executing the set of queries”.

Similar amendments have been made to claims 46 and 60.

Claim 1 has further been amended to further clarify that the limitation regarding “generating a set of queries” comprises “selecting a set of existing queries”. Similar amendments have been made to claims 46 and 60.

Claim 1 has further been amended to include the work “automatically”. The word “automatically” was included to clarify that executing a set of queries are performed automatically. Similar amendments have been made to claims 46 and 60.

Claim 1 has further been amended to recite subject matter that depends on a technology and is manipulated by the technology. Specifically, the phrase “the computer to perform” has been appropriately recited in the aforementioned claims.

Claims 21, 22, 24-37 and 50-56 have been cancelled and the Applicant reserves the right to pursue these claims in a continuing application.

Response to Elections/Restrictions

The office action requests cancellation of nonelected claims 21, 22, 24-37 and 50-56 that were previously withdrawn with traverse in Applicant’s Paper No. 9. In response, Applicant has cancelled the claims 21, 22, 24-37 and 50-56.

Response to Claim Rejections – 35 USC § 101

Claims 1-7, 10-20 and 57-59 stand rejected under 35 U.S.C. § 101 because the claims are allegedly directed towards subject matter that is not within the technological arts. Specifically, the Final Office Action states, “[t]he deficiencies in the present claim language may be overcome by expressly stating in the body of the claims the use of technology, such as a computer processor and/or a computer database”.

Claim 1 includes the following limitations:

receiving information about a patient utilizing a computer, the information about the patient including diagnosis information based upon a diagnosis of the patient performed by a health care provider; performing a query function utilizing the computer to retrieve from a database a list of data sources based upon the received information about the patient, the computer being operable to:
generate a set of queries containing query criteria based on the received information about the patient; the set of queries being selected from a set of existing queries that correspond to the received information about the patient;
and
automatically execute the set of queries to retrieve from the database the list of data sources matching the query criteria;
and
generating at least one document utilizing the computer, the at least one document containing the list of data sources retrieved from the database.

Claim 1 requires a computer for performing receiving, performing a query function and generating a document. It follows that claim 1 is within a "technological art" because claim 1 recites at least three computer-implemented operations. Consequently, claim 1 should not be rejected for the reason that it does not disclose any manipulation by a technology or dependence on the technology because claim 1 requires the computer to perform at least three computer-implemented operations.

In summary, claim 1 is not directed towards subject matter that is not within the technological arts as required to support a rejection of this claim under 35 U.S.C. § 101.

As dependent claims are deemed to include all limitations of claims from which they depend, the rejection of claims 2-7, 10-20 and 57-59 under 35 U.S.C. § 101 are also addressed by the above remarks.

Response to Claim Rejections - 35 USC § 102

Claims 1, 5-7, 10, 20, 38-39, 41-46, 48-49, 58 and 60 stand rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent No. 6,263,330 (hereinafter Bessette).

Applicant respectfully submits that claims 1, 5-7, 10, 20, 38-39, 41-46, 48-49, 58 and 60 should not be rejected under 35 U.S.C. § 102(e) for the reason that Besette does not disclose each and every limitation of the claim 1 of the present application.

To anticipate a claim, the reference must teach every element of the claim.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Claim 1 includes the following limitation:

performing a query function utilizing a computer...to:
generate a set of queries...selected from a set of existing queries that
correspond to the received information about the patient; and
automatically execute the set of queries...

The Office Action, in rejecting claim 1, contends that the above limitation is anticipated by the following disclosures in Besette:

At step 410 the doctor sits down at workstation 304 and logs onto the server 300, as will be discussed below. When prompted, the doctor uses the identifier obtained at either step 406 or step 408 in order to request the patient's NDSMR from the server 300. The record is transmitted from the NDSMR database 302 to the doctor's workstation.

Col. 7, lines 52-57 (first quote).

Yet another feature of this invention is its use as a search/query engine. Not only can a user perform searches for or queries on NDSMRs within his/her owl local Intranet, but also within external sources. NDSMR searches and queries may be performed on two different types of data, and therefore databases: nominative and non-nominative.In summary, the NDSMR system permits the delay-free consultation of pertinent information found within different local files and, for authorized users, offers an integrated research motor which allows for non-nominative research, by object or by concept, on the whole of the accessible databases.

Col. 15, lines 25-51 (second quote).

In short, the NDSMR record is data structure that contains two types of elements, namely a collection of medical data elements about the individual and one or more pointers that allow additional information to be downloaded, this additional information being of a medical nature and complementing the data held in the collection of medical data elements. Specific to this invention, these pointers adopt the URL (Universal Resource Locator) addressing system, allowing to point to a specific file.

Col. 13, lines 23-31 (third quote).

The interface allows the user to perform searches or queries on the NDSMR database, using information filters to simplify the extraction of pertinent data from what may be hundreds of thousands of network distributed shared medical records. The interface also allows the user to perform keyword-based Internet-wide searches, transparent to the user.

Col. 11, lines 45-51 (fourth quote).

The above four quotes from Bessette describe a request for a Network Distributed Shared Medical Record (NDMSR), a search/query engine, an NDMSR record, and an interface. The first quote describes a doctor that operates a workstation to request an NDMSR by providing an identifier to a server. In response to the request, the server transmits the NDMSR to the workstation.

The second quote describes a search/query engine that may be utilized by a user to perform a search/query on nominative and non-nominative databases. In addition the second quote also describes an integrated research motor that allows for non-nominative research, by object or by concept, on accessible databases.

The third quote from Bessette describes an NDSMR. The NDSMR is a medical record that contains medical data and pointers (URL's) that allow additional data to be downloaded.

Finally, the fourth quote describes an interface that allows a user to perform searches or queries on a database that includes NDMSR records. The interface provides filters to extract records and allows keyword-based Internet-wide searches.

Claim 1 requires a query function that selects a set of queries from a set of existing queries that corresponds to received information about a patient and automatically executes the

selected set of queries. For example, information is received about a patient, a set of queries are selected from a set of existing queries that correspond to the received information about the patient, and the selected queries are automatically executed. In contrast, the first quote from Besette does not describe performing a query function that selects and automatically executes a set of existing queries; but rather, a request in the form of an identifier that is utilized by a server to retrieve an NDMSR record. Certainly the first quote does not describe selecting a set of existing queries that correspond to received information about the patient. Indeed, such a limitation has been made unnecessary because the identifier by itself is sufficient to retrieve the NDMSR.

Moving on, the second quote from Besette does not describe a query function that selects and automatically executes a set of existing queries; but rather, the second quote identifies a search/query engine that may be utilized by a user to perform a search/query on one or more databases. The second quote simply does not describe a query function much less a query function that selects and automatically executes a set of existing queries. The same may be said for the integrated research motor that is also identified in the second quote.

The third quote from Besette also does not describe a query function that selects and automatically executes a set of existing queries; but rather, an NDMSR. As described above, the NDMSR is retrieved with an identifier and the identifier cannot be described as a query function that selects existing queries. Nevertheless, the third quote also describes the NDMSR as containing pointers that allow additional information to be downloaded; however, the first quote describes the server as transmitting the NDMSR that contains the pointers to a workstation. It follows that the server cannot automatically execute the set of existing queries because the server has transmitted the NDMSR that contains the pointers to the workstation.

Finally, the fourth quote does not describe a query function that selects and automatically executes a set of existing queries; but rather, an interface that provides filters to extract records and accept keywords for searches. Neither a filter nor a keyword can be described as a query function that selects and automatically executes a set of existing queries. Besette therefore cannot be said to anticipate the above quoted limitations from claim 1 because the above four quotes from Besette disclose a request for an NDMSR, a search/query engine, an NDMSR, and

an interface and claim 1 requires a query function that selects and automatically executes a set of existing queries.

In summary, Bessette does not disclose each and every limitation of claim 1, as required to support a rejection of this claim under 35 U.S.C. § 102(e).

In view of the remarks above, it is submitted that independent claims 38, 46 and 60 are also allowable.

As dependent claims are deemed to include all limitation of claims from which they depend, the rejection of claims 5-7, 10, 20, 37-39, 41-45, 48-49, and 58 under 35 U.S.C. § 102(e) is also addressed by the above remarks, and the amendments contained herein.

Response to Claim Rejections - 35 USC § 103

Claims 2-4, 11-16, 47, 57 and 59 stand rejected under 35 U.S.C. § 103(a), as being allegedly unpatentable over Bessette in view of U.S. Patent No. 5,924,074 (hereinafter Evans).

Applicant respectfully submit that claims 2-4, 11-16, 47, 57 and 59 should not be rejected under 35 U.S.C. § 103 for the reason that prior art references when combined do not teach or suggest all of the claim limitations of the independent claims of the present application.

To establish a **prima facie** case of **obviousness**, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

Claims 2-4, 11-16, 47, 57 and 59 depend on independent claim 1 and claim 47 depends on independent claim 46. If an independent claim is nonobvious under 35 U.S.C. § 103 then, any claim depending therefrom is nonobvious and rejection of claims 2-4, 11-16, 47, 57 and 59 under 35 U.S.C. § 103 is also addressed by the above remarks.

In summary, Bessette in combination with Evans does not teach or suggest each and every limitation of claims 2-4, 11-16, 47, 57 and 59 as required to support rejections of the independent claims of the present application under 35 U.S.C. § 103.

Claims 17-19 and 40 stand rejected under 35 U.S.C. § 103(a), as being allegedly unpatentable over Bessette in view of U.S. Patent No. 6,073,106 (hereinafter Rozen).

Applicant respectfully submit that claims 17-19 and 40 should not be rejected under 35 U.S.C. § 103 for the reason that prior art references when combined do not teach or suggest all of the claim limitations of the independent claims of the present application.

Claims 17-19 depend on independent claim 1 and claim 40 depends on independent claim 38. If an independent claim is nonobvious under 35 U.S.C. § 103 then, any claim depending therefrom is nonobvious and rejection of claims 17-19 and 40 under 35 U.S.C. § 103 is also addressed by the above remarks.

Therefore, Bessette in combination with Rozen does not teach or suggest each and every limitation of claims 17-19 and 40 as required to support rejections of the independent claims of the present application under 35 U.S.C. § 103.

In summary, Applicant believes that all rejections presented in the Office Action have been fully addressed and withdrawal of the rejections is respectfully requested. Applicant furthermore believes that all claims are now in a condition for allowance, which is earnestly solicited.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at 408-846-8871 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 4 day of January, 2005.

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